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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/688,006
Filing Date: October 17, 2003
Appellant(s): WHITE, RUSSELL T.

Nathan B. Davis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 28, 2011, appealing from the Office action mailed October 2, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: Claims 1-2, 5-8, and 10-22 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,466,918

Spiegel

10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 8 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 8 recites *inter alia* "receiving a selection, on the at least one computer device, of at least one item by the administrator for display on the high level page for each user in the group of users, wherein the selection determines which high frequency item of the identified plurality of high frequency items is displayed, if the high frequency item is displayed on a highest level page or the high level page and on which high level page the high frequency item is displayed, and wherein the selection can comprise an item that is not a high frequency item to be displayed on the highest level page or the high level page." There is almost nothing clear or definite in this claim. Among the indefinite features are that it cannot be clearly determined where and by what entity the selection is made. The examiner considers the most likely interpretations to be: 1. the selection is made on the at least one computer device and received by the administrator, or 2. the selection is made beyond the scope of the claim and received by the administrator on the at least one computer device. A third interpretation is that the selection is made by the administrator and received on the computer device, however this is the most stilted and strained interpretation and would therefore be assumed less likely to reflect appellant's intended understanding. These interpretations are not compatible with each other and therefore examiner considers the language indefinite rather than overly broad. The remainder of the claim lists a series of options determined by the selection, the origin of which is indeterminable. The series of

potential options intended to be selected or determined by the selection are not only chosen by an undefined entity but are unpredictable. While a series of options would not normally be indefinite in and of itself, here there is no way to determine how any of the options would have been selected. Finally, the last clause "wherein the selection can comprise an item that is not a high frequency item to be displayed on the highest level page or the high level page," further eliminates whatever vague notion of predictability might otherwise have been imagined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-8, and 10-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Spiegel (Paper #051102; US Patent No. 6,466,918).

Spiegel teaches all the limitations of Claims 1-2, 5-8, and 10-22. For example, with regard to method claims 1-2, 5-8, and 10-13, Spiegel discloses a method executed on at least one computer device of managing items available for electronic purchase, for storing items in a hierarchical structure, allowing users to select items within that structure, identifying frequently purchased items, and elevating them for display on a higher level in the structure than that on which they would normally appear (see at least Abstract, Figs. 1A-4, column 1 lines 5-15). Spiegel further discloses:

- storing items in a hierarchical structure: wherein each of the items is located using a database search query for each level of the hierarchical structure, wherein the query returns a set of records containing the items based on a level of the hierarchical structure selected and queried (see at least Abstract, Figs. 1A-8, column 1 lines 25-59, column 5 line 10-column 6 line 5, column 7 lines 5-25); a page is dynamically generated for a user at a user device based on the result of the query (see at least fig. 1A, column 2 lines 25-36, column 5 lines 3-10, column 7 lines 5-24, 59- column 8 line 8);
- storing historical data corresponding to operations performed: by each of a plurality of users in order to locate an item in the hierarchical structure, wherein the operations include each level and corresponding category of the hierarchical structure which were navigated by the plurality of users in order to locate the item (see at least abstract, figs. 1-4, 5, 7, 9, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 9 line 64-column 10 line 26);
- identifying at least one (a plurality of) high frequency item(s): corresponding to a high level page by analyzing the historical data to identify at least one item that is most frequently located from a high level of the hierarchical structure corresponding to the high level page, items are frequently located from a corresponding level of the hierarchical structure (see at least column 2 lines 36-67, column 6 lines 30-67, column 11 lines 34-67); maintaining a record of the frequency that each of the items has been purchased (see at least Abstract, column 2 lines 12-24, column 3 lines 13-29, column 6 lines 5-20, 30-39. Please

note: this element is interpreted as referring to the storage of information regarding the frequency of purchase of each item.); a separate record of the frequency of purchase of each of the items is maintained for each of a plurality of groups of users (see at least column 7 line 59-column 8 line 7, column 9 line 64 – column 10 line 16.);

- receiving a request for a high level page: on the at least one computer device the high level page corresponding to a high level of the hierarchical structure, from a user in the group of users (see at least column 9 line 1—column 10 line 37, column 11 lines 34-50, column 15 line 55 – column 16 line 60);
- automatically generating on the at least one computer device: the high level page using the query for the corresponding high level of the hierarchical structure and the identified (selected) at least one high frequency item to display the at least one high frequency item on the high level page wherein the high level page is dynamically generated by the at least one computer device in response to receiving the request for the high level page and incorporates the selection of the administrator (see at least Abstract, Figs. 1A,2-4,11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 7 lines 5-25);
- presenting the at least one high frequency item to an administrator: for the group of users and receiving a selected at least one high frequency item for display on the high level page for each user in a group of users wherein the administrator determines if the at least one high frequency item is displayed on a high level page and on which high level page the at least one high frequency item is

displayed (see at least abstract, figs. 1A, 2-4, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 4 line 64-column 5, column 6 lines 5-20, column 7 lines 5-25, column 13 lines 40-50, column 15 lines 10-25);

- receiving a selection: on the at least one computer device of at least one item by the administrator for display on the high level page for each user in the group of users, wherein the selection determines which high frequency item of the identified plurality of high frequency items is displayed, if the high frequency item is displayed on a highest level page or the high level page and on which high level page the high frequency item is displayed, and wherein the selection can comprise an item that is not a high frequency item to be displayed on the highest level page or the high level page (see at least abstract, figs. 1A, 2-4, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 4 line 63-column 5 line 67, column 7 lines 5-25, column 13 lines 40-50, column 15 lines 10-25. Please note: The optional claim language regarding what actions may or may not be taken by the administrator does not result in any further limitation because it merely represents contingencies that are not required. The optional activities of the administrator do not represent clearly defined method steps that definitely take place. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" and In re

Johnston, 435 F.3d 1381,77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted."));

- storing the operations performed by a user to select an item in the hierarchical structure: analyzing the stored operations, obtaining the query for each level based on the stored operations (see at least Abstract, Figs. 1-4,5,7,9,11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 9 line 64-column 10 line 26.).
- an identification system for identifying a user: (see at least column 2 line 46 – column 3 line 12, column 6 line 40 – column 7 line 5, column 11 lines 34-50, column 12 line 61 – column 13 line 7).

Pertaining to system claims 14-18

Rejection of system claims 14-18 is based on the same rationale as noted above. For example, any system capable of performing the above disclosed method must at the very least inherently include elements capable of performing the above disclosed steps.

Pertaining to computer program product claims 19-22

Rejection of computer program product claims 19-22 is based on the same rationale as noted above. In addition, Spiegel discloses:

- a computer program product: stored on a non-transitory computer readable medium (see at least column 6 lines 5-20, column 8 lines 14-21, column 10 lines 17-37).

(10) Response to Argument

Pertaining to rejection of claims 8 and 10-13 under 35 U.S.C. 112 second paragraph

It is examiner's position that this is a prima facie case of indefiniteness and the rejection stands on its own merits. Examiner considers the source of the indefiniteness to be the following most likely interpretations: 1. the selection is made on the at least one computer device and received by the administrator, or 2. the selection is received by the administrator on the at least one computer device. Both interpretations indicate the selection is being made by an entity other than the administrator, and yet both interpretations are incompatible with each other. The examiner therefore considers the language indefinite rather than merely overly broad. Appellant's argument addresses the third interpretation. This interpretation is incompatible with the other two interpretations, providing further support for the ground of rejection.

Because the claim does not clearly describe the step of an entity making a selection, but is rather directed to receiving a selection made elsewhere, it is unclear whether the elements describing the selection are intended as being functionally claimed or are merely descriptive of the received selection. Furthermore the description of the selection, or of what is intended to be selected or determined by the selection, is just a series of potential options that would appear to be arbitrarily chosen by an indefinite entity. While a series of options would not normally be indefinite in and of itself, it is here because there is no way to determine how any of the options would have been selected.

Pertaining to rejection of claims 1-2, 5-8, and 10-22 under 35 USC 102(b)

Independent Claim 1

Appellant argues that the references fail to show "storing historical data corresponding to operations performed by each of a plurality of users in order to locate an item in the hierarchical structure, wherein the operations include each level and corresponding category of the hierarchical structure which were navigated by the plurality of users in order to locate the item." "Historical data" is not described, introduced, or even for that matter mentioned whatsoever in the specification and therefore can only be understood as the previously claimed feature of, *inter alia*, storing operations performed by users. This previously claimed feature is described in the specification. Were it not the same it would be new matter because the specification's support for this feature merely describes the previously claimed feature of storing operations performed by users. In any case, while the present application does not use the term "historical data" in describing the concept, the prior art does. The reference describes the storage and analysis of "historical data" in great detail as would be clear from even a cursory glance at the abstract, figures, or for that matter almost any randomly chosen page of the disclosure. For example:

"A computer-implemented system and method are provided for identifying popular nodes within a browse tree or other hierarchical browse structure based on historical actions of online users, and for calling such nodes to the attention of users during navigation of the browse tree. The system and method are particularly useful for assisting users in locating popular products and/or product categories within a catalog of an online merchant, but may be used in connection with browse structures used to locate other types of items. Node popularity levels are determined periodically (e.g., once per

day) based on recent user activity data that represents users' affinities for such nodes. Such activity data may include, for example, the number of times each item was purchased, and/or the number of times each category was selected for display, within a selected period of time. Popular nodes are called to the attention of users by automatically "elevating" the nodes for display within the browse tree." (abstract, lines 1-17).

Examiner's position is that the above rejection, including the cited portions of the reference and the reference as a whole stand on their own. It is difficult to create a meaningful response to appellant's arguments because the arguments merely focus upon whichever small portion of cited subject matter does not explicitly disclose the relevant claim element using the exact same terminology and then declare that the elements are therefore not present anywhere in the cited portions or the remainder of the reference. The arguments are rooted in the inevitable likelihood that two independently drafted disclosures will use differently styled language, terms, and phrases to describe the same features. Unfortunately, the need for identical features does not mean they need to be described using identical language.

A simple reading of the cited portions would clearly show the presence of the claimed features to a person of ordinary skill in the art. For example, appellants state, "With no specific teaching of determining the "popularity" in Spiegel, the method is not equivalent to Appellant's claimed historical data." Appeal Brief page 10. Examiner simply does not understand how anyone of any skill in any art could read any significant portion of the reference and come to the conclusion that there is "no specific teaching of determining the 'popularity.'" It is also noted that appellant's specific arguments are not directed to the claim language but to mere characterizations of the claim language. For

example, appellants admit that a portion of the prior art discusses "recording and storing which items are browsed or purchased within a time frame," but argue that "this portion makes no reference to storing the specific actions taken to locate a certain item."

Appeal Brief page 10. Examiner notes first that while the reference goes into significantly more specific detail, browsing alone can also be considered a specific action taken to locate a certain item. Second, examiner notes that "storing the specific actions taken to locate a certain item" is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Finally, appellants admit that the prior art discloses, "keeping a record of all purchases made by a user and if there was any web activity as well, which is clearly user specific" but then argue that these admitted user specific operations are "not based on 'operations performed by each of a plurality of users.'" *Ibid*. Examiner's position is that appellant's argument is not only inconsistent with the prior art but inconsistent with appellant's own admissions.

Pertaining to claim 2

Appellant declares that only one of the cited passages "discusses the role of an Administrator." Appeal Brief page 11. This is incorrect. At least three of the cited portions specifically discuss the administrator, while all of the cited portions describe the system's (and therefore the system administrator's) capacity to "tune" the system, adjust weightings, organize the browse tree, and select or modify the items and item

categories therein. These activities would include elevating nodes, as would be understood by one of ordinary skill reviewing the cited passages with a general understanding of the entirety of the disclosure. The prior art disclosure is clearly presenting an equivalent administrator with equivalent capabilities. Further, appellant misunderstands the meaning of "teaching away." The disclosure of the prior art includes the capacity for node elevation either automatically or by the system administrator. The "prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Pertaining to claims 5-7

Appellant relies on argument pertaining to claim 1, from which these claims depend. These claims therefore stand or fall based on the determination with regard to claim 1.

Pertaining to claim 8

Appellant relies on previous arguments in support of claim 8 and the examiner therefore does the same. Although appellant appears to separately argue a portion of claim 8 pertaining to the administrator, examiner notes that the argument is the same as that directed to claim 2 above and examiner therefore relies on the responsive argument directed to claim 2 in support of affirming the rejection. It is further noted that,

per the rejection under 35 USC 112, second paragraph, examiner does not believe the argued portion of claim 8 can be considered sufficiently definite to allow a clear basis for separate argument either for or against. Examiner further notes with regard to the administrator that if appellant's argued interpretation is assumed (in order to allow a thorough response) then the administrator is apparently a human being given the power to arbitrarily rearrange items as it chooses. Notwithstanding all of the previously discussed bases for indefiniteness then, this at least makes clear that the administrator has the option of selecting any one of the listed actions or no action at all solely at its whim. Furthermore, although the selection determines which option is applied, the actual selecting by the administrator is not claimed as a step in the method. The claimed step of the method is the receipt of the selection on at least one computer device. In order to anticipate the claim the prior art therefore need only disclose receiving a selection made by an administrator wherein said administrator has the ability to select any one of the listed actions or no action at all. In other words, the prior art need only receive an administrator's command to perform any one of the selected actions or no action at all.

Optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" and In re Johnston, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)

("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

Pertaining to claims 10-13

Appellant relies on argument pertaining to claim 8, from which these claims depend. These claims therefore stand or fall based on the determination with regard to claim 8.

Pertaining to claim 14

Appellant relies on previous arguments in support of claim 14. Examiner therefore does the same, and in addition it is examiner's position that the rejection speaks for itself.

Pertaining to claims 15-18

Appellant relies on argument pertaining to claim 14, from which these claims depend. These claims therefore stand or fall based on the determination with regard to claim 14.

Pertaining to claim 19

Appellant relies on previous arguments in support of claim 19. Examiner therefore does the same, and in addition it is examiner's position that the rejection speaks for itself.

Pertaining to claims 20-22

Appellant relies on argument pertaining to claim 19, from which these claims depend. These claims therefore stand or fall based on the determination with regard to claim 19.

For all of the reasons noted above examiner respectfully requests that the Board affirm the rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3625

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Adam Levine/

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